

REMARKS

This is a full and timely response to the non-final Office Action mailed on June 29, 2004 (Paper No. 20040625). Claims 6, 29, 31, and 36 are canceled. Accordingly, claims 1-5, 7-28, 30, 32-35, and 37 are currently pending in the current application. Reconsideration and allowance of the application and presently pending claims are respectfully requested in view of the foregoing remarks. Applicant should not be presumed to agree with any statements made by the Examiner in the Office Action unless otherwise specifically indicated by the Applicant.

I. Rejection under 35 U.S.C. 103(a)

Claims 1-37 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,880,720 to *Iwafune*. In order for a claim to be properly rejected under 35 U.S.C. §103, the teachings of the prior art reference must suggest all features of the claim invention to one of ordinary skill in the art. *See, e.g., In re Dow Chemical*, 837 F.2d 469, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988); *In re Keller*, 642 F.2d 413, 208 U.S.P.Q. 871, 881 (C.C.P.A. 1981).

A. Claim 1

Claim 1, as amended, recites:

1. (Currently Amended) A media services device, comprising:
a memory for storing subscriber identification information; and
a processor configured to receive the subscriber identification information and a media presentation, wherein the processor is further configured to insert the subscriber identification information into the media presentation, wherein the processor is located in a media services client device, wherein ***the processor is configured to insert the subscriber identification information into the media presentation during a vertical blanking interval of the presentation of the media presentation, wherein the subscriber identification information is invisible to a viewer of the media presentation.***

(Emphasis Added)

Applicant respectfully submits that *Iwafune* fails to disclose, teach, or suggest the feature of “the processor is configured to insert the subscriber identification information into the media presentation during a vertical blanking interval of the presentation of the media presentation,

wherein the subscriber identification information is invisible to a viewer of the media presentation.” As an initial matter, *Iwafune* discloses in Column 1, lines 9-14 as follows:

The present invention relates to a technique pertaining to an interactive television capable of selecting interactive TV programs in which a viewer can participate and, more particularly, to a television system for providing application services using the interactive TV set.

By enabling the viewer to participate in TV programs, *Iwafune* apparently discloses information that is transmitted to a television is displayed to the viewer. In fact, *Iwafune* discloses in Column 16, line 58 – Column 17, line 30 as follows:

By the processing in step (1), a teletext (coded transmission teletext) video signal formed by embedding the script in which transfer destination information (e.g., a phone number) is embedded is transmitted in the transmission form shown in FIGS. 20A and 20B during the [vertical blanking interval] VBL. More specifically, the script (including a script main body (program unit) describing the procedure, a header, a form, and a resource) for providing a plurality of different pieces of additional information linked with the image information and the phone number embedded in the script are transmitted during the vertical blanking interval (VBL) contained in the video signal. As an example, shopping information provided by the VTR is transmitted together with a client phone number.

In step (2), the interactive television 60 receives the video signal into which the shopping information reproduced by the VTR is inserted, and stores (buffers) the reception script contained in the signal. That is, the multimedia teletext receiving circuit 63 of the interactive television 60 discriminates the VBL data from the transmitted video signal and separates the data into data of regular image information and data of a plurality of different pieces of additional information linked with the image data. The receiving circuit 63 generates display data of the regular image information and display data of the plurality of different pieces of additional information linked with the image information and stores (buffers) these display data in the RAM 83.

In step (3), the viewer makes the interactive mode valid by operating the mode switching key (i key) of the remote control unit 65. Consequently, a mark "i" as shown in FIG. 21A is displayed in the upper left corner of the display (CRT) 62 to indicate that the interactive mode is set. Additionally, a screen shown in FIG. 21B is displayed to check whether the viewer wants shopping.

When the mode switching key (i key) is operated, the CPU 81 executes the processing of the script processing module ›SCR! in the ROM 84, and this allows the interactive teletext decoder to execute the script processing. As a consequence, an additional information selection screen (shopping selection screen) as shown in FIG. 22A is displayed (step (4)).

(Emphasis Added)

Apparently, *Iwafune* discloses that *Iwafune* additional information is displayed upon the request of a user and so the *Iwafune* additional information is not kept invisible during the *Iwafune* media presentation. Consequently, Applicant respectfully submits that *Iwafune* fails to disclose, teach, or suggest “the processor is configured to insert the subscriber identification information into the media presentation during a vertical blanking interval of the presentation of the media presentation, wherein the subscriber identification information is invisible to a viewer of the media presentation,” as recited in claim 1. A prima facie case of anticipation cannot be established. Accordingly, for this reason, among others, Applicant respectfully requests that claim 1 be allowed and the rejection be withdrawn.

B. Claims 2-5 and 7-18

Because independent claim 1 is allowable over the cited art of record, dependent claims 2-5 and 7-18 are allowable as a matter of law for at least the reason that dependent claims 2-5 and 7-18 contain all features and elements of their respective independent base claim. *See, e.g., In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). Accordingly, Applicant respectfully requests that the rejection to dependent claims 2-5 and 7-18 be withdrawn for at least this reason, among others.

Regarding claim 2-5, 9, and 13-16, the Examiner has taken Official Notice that “it is well known in the art that a media presentation is sent via an in-band or out-band signal and therefore would be obvious with IWAFUNE in order to distribute the media presentation as well as the subscriber information.”

According to MPEP 2144.03, “It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known.” MPEP 2144.03 also states that “If such notice is taken, the basis for such reasoning must be set

forth explicitly. The Examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge."

Applicant respectfully traverses the Examiner's Official Notice for at least the following reasons:

1. The fact sought to be established by the Official Notice is not capable of "instant and unquestionable demonstration as being well-known."
2. The basis for the Official Notice was not set forth explicitly.
3. The Examiner did not provide specific factual findings predicated on sound technical and scientific reasoning to support the conclusions of common knowledge.
4. The Examiner failed to cite documentary support for the Official Notice.

C. Claim 19

Claim 19, as amended, recites:

19. A method for inserting subscriber identification information into media presentations, the method comprising steps of:
receiving subscriber identification information;
storing the subscriber identification information in memory;
receiving a subscriber request for a media presentation; and
inserting the subscriber identification information into the media presentation requested by the subscriber, wherein the inserting of the subscriber identification information occurs at the media services client device, wherein *the media services client device inserts the subscriber identification information into the media presentation during a vertical blanking interval of a presentation of the media presentation, wherein the subscriber identification information is invisible to a viewer of the media presentation.*

(Emphasis Added)

As mentioned above with reference to claim 1, *Iwafune* apparently discloses that *Iwafune* additional information is displayed upon the request of a user and so the *Iwafune* additional information is not kept invisible. Consequently, *Iwafune* fails to disclose, teach, or suggest "the media services client device inserts the subscriber identification information into the media presentation during a vertical blanking interval of a presentation of the media presentation, wherein the subscriber identification information is invisible to a viewer of the media presentation", as recited in claim 19. A prima facie case of anticipation cannot be established.

Accordingly, for this reason, among others, Applicant respectfully requests that claim 19 be allowed and the rejection be withdrawn.

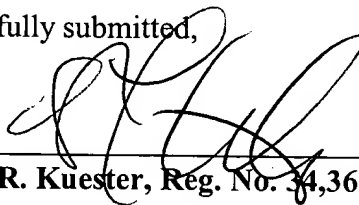
D. Claims 20-28, 30, 32-36, and 37

Because independent claim 19 is allowable over the cited art of record, dependent claims 20-28, 30, 32-36, and 37 are allowable as a matter of law for at least the reason that dependent claims 20-28, 30, 32-36, and 37 contain all features and elements of their respective independent base claim. *In re Fine*, supra. Accordingly, Applicant respectfully requests that the rejection to dependent claims 20-28, 30, 32-36, and 37 be withdrawn for at least this reason, among others.

CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above, Applicant respectfully submits that all rejections have been traversed and that the now pending claims 1-5, 7-28, 30, 32-35, and 37 are in condition for allowance. Favorable reconsideration and allowance of the present application and pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephone conference would expedite the examination of this matter, the Examiner is invited to contact the undersigned agent at (770) 933-9500.

Respectfully submitted,



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